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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,900	07/02/2003	John D. McEnroe JR.	MCEJ101.CIP	6838
21261	7590	06/07/2006	EXAMINER	
ROBERT PLATT BELL REGISTERED PATENT ATTORNEY P.O. BOX 310 AURORA, NY 13026			SAFAVI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3673	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/613,900	<b>Applicant(s)</b> MCENROE, JOHN D.	
	<b>Examiner</b> M. Safavi	<b>Art Unit</b> 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-19 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) 4, 7, 8, 12, 14, 17-19 and 22-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 9, 10, 13, 15, 16, 21, and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Specification***

The substitute specification filed January 11, 2005 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: a statement has not accompanied the substitute specification that the substitute specification includes no new matter.

### ***Drawings***

The drawings were received on January 11, 2005. These drawings have not been entered. Applicant has not provided a detailed explanation of all changes to the drawings provided on substitute drawing sheets 1-20. In accordance with 37 CFR 1.121(d), "[a]ll changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper." As per 37 CFR 1.121(d)(2), a marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided.

### ***Claim Objections***

Claim 13 is objected to because of the following informalities: Line 2 of claim 13 should recite —having a wall thickness—rather than "has a wall thickness". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5, 6, 9, 10, 13, 15, 16, 21, and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification had not originally presented a "*non-structural...tubular segment*" as is now recited in claim 29. The specification had not originally presented a polymer material having "a thickness less than 0.2 millimeters" as is presented in claims 1 and 10. Since the specification only has support for a range of 0.1 to 1.0 millimeters, the language "less than 0.2 millimeters" in line 10 of claim 1 and line 11 in claim 10 covers values less than 0.1 millimeters, which have not been disclosed by the originally filed specification.

Further, it is not clear as to what is being defined by "such that the form support member is erected on a surface internal to a sidewall of the pliable tubular segment". Does the language at line 8-9 of claim 29 merely recite an intended assembly? Claim 29, otherwise, appears directed to a kit comprising "a tubular segment" and "a form support assembly". Claim 29 does not appear to positively set forth a form support member as part of the claimed invention to be patented. Nor, does any specific relationship between parts appear to be positively set forth.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 10, 13, 15, 16, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 appears to present a range of thickness which includes values falling outside of the range of thickness presented within claim 2 from which claim 3 depends.

Claim 10, lines 8-9, it is not clear as to what is being defined by the recitation "around the form support member from the form support member".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Grafton '206.**

Grafton '206 discloses a pliable tubular segment 5 formed of a polymer material with a form suspension assembly 19/20 serving to hold the tubular segment to a form support member 23.

Claim 29 appears directed to a kit comprising "a tubular segment" and "a form support assembly". Claim 29 does not appear to positively set forth a form support member as part of the claimed invention to be patented. Nor, does any specific relationship between parts appear to be positively set forth.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 5, 6, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grafton '206 in view of Lafleur '482.**

Grafton '206 discloses a pliable tubular segment 5 formed of a polymer material with a form suspension assembly 19/20 serving to hold the tubular segment to a form support member 23. A suspension assembly connector is at 20 with support arm at 19 and support ring 18 supported by the support arm 19 and attached to the tubular segment 5. Grafton does not appear to specifically disclose a tubular segment having a thickness of substantially 0.1 to 0.2 millimeters.

However, Lafleur '482 discloses forming a polymeric bag or liner of a thickness on the order of 4-10 millimeters, col. 1, line 18. Therefore, to have formed the Grafton tubular segment 5 of a thickness on the order of 0.1-0.2 millimeters, thus providing a durable tubular segment form, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Lafleur '482.

Claims 1 and 29 appears directed to a kit comprising "a tubular segment" and "a form support assembly". Claims 1 and 29 do not appear to positively set forth a form support member as part of the claimed invention to be patented. Nor, does any specific relationship between parts appear to be positively set forth.

**Claims 1-3, 9, 10, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turzillo '989 in view of Grafton '206 when considering Lafleur '482.**

Turzillo '989 discloses, Fig. 26, a pliable tubular segment 55 with a form suspension assembly 60 serving to hold the tubular segment to a form support member 59. A form positioning and dampening assembly attachable to the form support member and a surface is at 59b or is at the lower most portion of the tubular segment. Turzillo does not appear to specifically disclose a tubular segment formed of a polymer material having a thickness of substantially 0.1 to 0.2 millimeters.

However, Grafton '206 teaches a form 5 of polymer material while Lafleur '482 discloses forming a polymeric bag or liner of a thickness on the order of 4-10 millimeters, col. 1, line 18. Therefore, to have formed the Kim tubular segment 12 of a

polymer material having a thickness on the order of 0.1 to 0.2 millimeters, thus providing a durable tubular segment form, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Grafton '206 when considering Lafleur '482.

**Claims 1-3, 5, 6, 9, 10, 13, 15, 16, 21 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim '929 in view of Grafton '206 when considering Lafleur '482.**

Kim '929 discloses, Figs. 1, 11, and 13-19, a pliable tubular segment 12 with a form suspension assembly 14 serving to hold the tubular segment to a form support member 38. A form positioning and dampening assembly attachable to the form support member and a surface is at 32, for example. Support ring is at 14 with support arm at 28. Kim does not appear to specifically disclose a tubular segment formed of a polymer material having a thickness of substantially 0.1 to 0.2 millimeters.

However, Grafton '206 teaches a form 5 of polymer material while Lafleur '482 discloses forming a polymeric bag or liner of a thickness on the order of 4-10 millimeters, col. 1, line 18. Therefore, to have formed the Kim tubular segment 12 of a polymer material having a thickness on the order of 0.1 to 0.2 millimeters, thus providing a durable yet light-weight tubular segment form, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Grafton '206 when considering Lafleur '482.



**Claims 1-3, 5, 6, 9, 10, 13, 15, 16, 21 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aguilera '439 in view of Grafton '206 when considering Lafleur '482.**

Aguilera '439 discloses, Figs. 1, 3, 5, 7, 10, and 15, a pliable tubular segment 10 with a form suspension assembly 60 serving to hold the tubular segment to a form support member 62 or 12. A form positioning and dampening assembly attachable to the form support member and a surface is at 56/58, for example. Support ring is at 12, 12' with support arm at 62. Aguilera does not appear to specifically disclose a tubular segment formed of a polymer material having a thickness of substantially 0.1 to 0.2 millimeters.

However, Grafton '206 teaches a form 5 of polymer material while Lafleur '482 discloses forming a polymeric bag or liner of a thickness on the order of 4-10 millimeters, col. 1, line 18. Therefore, to have formed the Aguilera tubular segment 10 of a polymer material having a thickness on the order of 0.1 to 0.2 millimeters, thus providing a durable yet light-weight tubular segment form, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Grafton '206 when considering Lafleur '482.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5, 6, 9, 10, 13, 15, 16, 21, and 29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-11 and 13 of copending Application No. 10/264,094. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 9-11 and 13 of Application No. 10/264,094 present an assembly comprising a linear form support member, a polymer tubular segment having a wall thickness of less than 0.2 millimeters, and a form suspension assembly as well as a form positioning and dampening assembly with the form suspension assembly comprised of a suspension assembly connector, a support arm, and a support ring. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the various elements presented within claims 9-11 and 13 of Application No. 10/264,094 in any varying manner, including that presented by any of claims 1-3, 5, 6, 9, 10, 13, 15, 16, 21, and 29 of the instant application, in order to utilize such elements as may be deemed necessary in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 10, and 29 have been considered but are moot in view of the new ground(s) of rejection. In any event, each of claims 1, 10, and 29, particularly claims 1 and 29, merely present a "tubular segment" and "form suspension assembly" with no specific relationship between the recited elements.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**MICHAEL SAFAVI**  
**PRIMARY EXAMINER**  
**ART UNIT 3673**

M. Safavi  
May 22, 2006